



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,842	07/15/2003	Nigel Evans	07319-091002	8792

20985 7590 12/07/2004

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

EXAMINER

CHARLES, MARCUS

ART UNIT	PAPER NUMBER
----------	--------------

3682

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,842

Applicant(s)

EVANS, NIGEL

Examiner

Marcus Charles

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

This action is responsive to the amendment filed 09-01-2004, which has been entered. Claims 2-21 are currently pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-9, 11-15 and 17, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cleveland (4,161,000) in view of Wharton (2,753,812). Cleveland discloses a system (10), comprising a pulley (36) adjacent a heat source (16), and rotating to control an object, a motor (30) on a first side of the pulley and away from the heat source, a belt (32) entrained around the frictional outer peripheral surface the pulley and connected to the motor shaft via a pulley. Cleveland does not disclose a belt redirecting mechanism holding the belt around the frictional surface of the motor pulley and a side of the driven pulley. Wharton discloses a redirecting mechanism holding a double-sided belt (26) between a motor and a driven pulley in order to achieve efficient power-take off without slippage, to reduce pressure on the belt during operation and to make it easier to provide proper tension on the belt. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Cleveland device to include the limitations of Wharton in

Art Unit: 3682

order to achieve efficient power-take off without slippage, to reduce pressure on the belt during operation and to make it easier to provide proper tension on the belt

In claim 3, note the rotation device of Wharton include first and second idlers (22, 24) spaced from each other on opposite sides.

In claim 4, note the belt of Wharton includes a frictional surface on both sides.

In claim 5, note, the idlers are arranged to engaged the first side of the belt and the driven pulley are arranged to engage the second side of the belt.

In claims 6-9, note the light beam changing mechanism (18/20) of Cleveland and it is apparent that the light beam changing mechanism alters and changes the shape of the light.

Regarding claims 11-15, 17, it is apparent that the method steps are inherently included during the manufacturing of Cleveland in view of Wharton device.

3. Claims 10, 16 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cleveland in view of Wharton as applied to claim 1 above, and further in view of Demick et al. ('643). Cleveland does not disclose the intensity of the light. Demick discloses a light having an intensity of up to 1200 watts (which is greater than 300 W). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Cleveland device to include a light intensity of Demick in order to provide proper illumination and to reduce time of heat concentration.

Art Unit: 3682

In claims 19-21, Cleveland in view of Wharton discloses the claimed invention above.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 2-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1- 23 of U.S. Patent No. 6,592,480. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations in the breath and scope.

Response to Arguments

6. Applicant's arguments filed 10-01-2004 have been fully considered but they are not persuasive. Applicant contended that one of ordinary skill would have no incentive to modify Cleveland device so as to arrange the belt drive as Wharton because the Wharton device would require a greater torque than Cleveland device. It should be noted that the system of Wharton would make the

Art Unit: 3682

system of Cleveland more stable. Any system that is controlled by the speed of a motor requires a certain amount of torque. In most circumstances the speed and torque produce by a motor fluctuates and the design of the belt arrangement of Wharton would limit the effects of the fluctuations. Therefore, one of ordinary skill would use the Wharton arrangement to limit the effects of the fluctuations of the motor and thus proving stability for the system of Cleveland.

Regarding applicant's argument pertaining to claim 7, applicant contended that the changing mechanism of Cleveland is apparently a shutter. It should be noted that these shutters in combination with the lens (12) control the lights passing through the optical axis. It should be note that the color of the lights will inherently change as the lights filters through. Regarding claim 17, it is apparent that the Wharton would inherently allow the rotating system to be closer to the light than the belt.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of Cleveland and Wharton is proper.

Art Unit: 3682

8. In addition, applicant should submit an argument regarding the Double Patenting Rejection, pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Conclusion


9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus Charles whose telephone number is (703) 305-6877. The examiner can normally be reached on Monday-Thursday 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on (703) 308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Marcus Charles
Primary Examiner
Art Unit 3682
December 05, 2005